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| 09/661,540      | 09/14/2000  | Duane Allen          | MPATENT.167A        | 9050             |

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EXAMINER

MCARDLE, JOSEPH M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2132

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/661,540

Applicant(s)

ALLEN, DUANE

Examiner

Joseph McArdle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9-13, 16-18 and 22-26 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8, 14, 15 and 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because portions of the drawings are hand written. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6, 7, 11, 16, 22, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Nardone (U.S. Patent No. 6175925). In regards to claim 1, Nardone discloses a design that pertains to a tamper resistant player for scrambled content. Nardone then goes on to disclose in column 1,

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lines 20-30 that content management (such as the management of DVD contents) requires that the integrity of the management operations be verified and that there are numerous approaches used in doing so, such as encryption and decryption, which are well known in the art. Nardone then describes in Fig. 9 the various components of the tamper resistant player for scrambled contents, which includes a processor, system memory and I/O devices that can be used to accept removable media (such as DVDs). Nardone then describes in column 6, lines 13-15 how a signature is pre-stored in a predetermined location in order to facilitate the start-up and run-time integrity. These disclosures by Nardone meet the limitations set forth under claim 1 that call for having a host processor coupled to a removable media device (see Fig. 9) and a non-volatile memory coupled to the processor having a predetermined location for storing a signature. Nardone then discloses in column 3, lines 45-65 and in Figs. 2 and 3 how the system uses the pre-stored signature in order to verify integrity during start-up and how the application will terminate if integrity verification is not confirmed through the use of the pre-stored signature, which in turn will not allow for the decoding of the scrambled contents. (see column 6, lines 16-20 where Nardone discloses the decoding process). These disclosures by Nardone meet the remaining limitations set forth under claim 1, that call for having a boot-up program that will only be configured to decode encoded media if the signature is stored in a predetermined location because in Nardone's design if the pre-stored signature is not present, the authentication and integrity checks will not be

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verified which in turn means that the media/data will not be descrambled/decoded.

3. In regards to claim 2, Nardone discloses a design that pertains to a tamper resistant player for scrambled content. Nardone then goes on to disclose in column 5, lines 55-60 and in column 6, lines 6-20 how the decoder receives scrambled compressed content and determines if the content provided is authenticated to be decoded (descrambled) by the content player. These disclosures by Nardone meet the limitations set forth under claim 2 that call for determining whether the system is authorized to decode requested encoded data and if the system is authorized to decode the encoded data and the first sector is encoded, decoding the data because in Nardone's design described above the content player first authenticates with the scrambled/encoded content (column 6, lines 6-10) and if the scrambled/encoded content and the content player are authenticated with one another then the content player can decode/descramble the scrambled/encoded content (see column 6, lines 15-20).

4. In regards to claim 3, Nardone discloses in column 6, lines 13-15 how a signature is pre-stored in a predetermined location to facilitate start-up and run-time integrity. Nardone then discloses in Figs. 2 and 3 and in column 3, lines 45-65 how the system uses the pre-stored signature in order to authenticate system integrity during start-up time and how the application will terminate if the integrity verification is not confirmed through the use of the predetermined signature. These disclosures by Nardone meet the limitations set forth under claim 3 that call for verifying that a signature is stored in a predetermined memory location

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because in Nardone's design, if the pre-stored signature is not present, the authentication and integrity checks will not be verified which in turn will not allow the scrambled/encoded content to be descrambled/decoded.

5. In regards to claims 6 and 22, Nardone discloses a design that pertains to a tamper resistant player for scrambled content. Nardone further discloses in column 7, lines 61-67 through column 8, lines 1-6 and in Fig. 9 the various components associated with the computer system. These disclosures include a processor, system memory and I/O devices that are used to accept removable media (such as DVDs). Nardone then discloses in column 6, lines 6-20 a tamper resistant decoder that is used to decode encoded media content. These disclosures meet the limitations set forth under claims 6 and 22 that call for having a memory resident program with a lockable decoding function that is capable of preventing unauthorized access to encoded content because in Nardone's design the tamper resistant decoder is used to control access to encoded media content. Nardone then goes on to disclose in Figs. 2 and 3 and in column 3, lines 45-65 how the system uses a pre-stored signature in order to authenticate system integrity during start-up time and how the application will terminate if the integrity verification is not confirmed through the use of the pre-stored signature. Nardone further discloses in column 5, lines 55-60 and in column 6, lines 6-20 how the decoder receives scrambled and compressed content and determines if the content provided is authenticated to be decoded (through the use of the previously disclosed pre-stored signature). These disclosures by Nardone meet the limitations set forth under claims 6 and 22 that

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call for determining whether the system is authorized to decode requested encoded data and if the first sector is encoded, decoding the data because in Nardone's design described above the content player/decoder first authenticates with the scrambled/encoded content and the content player/decoder are authenticated with one another then the content player/decoder can decode/descramble the encoded content (see column 6, lines 15-20).

6. In regards to claims 11, 16 and 26, Nardone discloses a design that pertains to a tamper resistant player for scrambled content. Nardone further discloses in column 7, lines 61-67 through column 8, lines 1-6 and in Fig. 9 the various components associated with the computer system. These disclosures include a processor, system memory and I/O devices that are used to accept removable media (such as DVDs). Nardone then discloses in column 6, lines 6-20 a tamper resistant decoder that is used to decode encoded media content. These disclosures meet the limitations set forth under claims 11, 16 and 26 that call for inserting a driver with a lockable decoding function between the operating system and the removable media reader (I/O device) to control the transfer of information because the tamper resistant decoder disclosed in Nardone's design acts as a lockable decoding function that servers to control the transfer and decoding of information between the I/O devices (media readers) and the system processor (operating system). Nardone then goes on to disclose in Figs. 2 and 3 and in column 3, lines 45-65 how the system uses a pre-stored signature in order to authenticate system integrity during start-up time and how the application will

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terminate if the integrity verification is not confirmed through the use of the pre-stored signature. Nardone further discloses in column 5, lines 55-60 and in column 6, lines 6-20 how the decoder receives scrambled and compressed content and determines if the content provided is authenticated to be decoded (through the use of the previously disclosed pre-stored signature). These disclosures by Nardone meet the limitations set forth under claims 11, 16 and 26 that call for determining whether the system is authorized to decode requested encoded data and if the first sector is encoded, decoding the data because in Nardone's design described above the content player/decoder first authenticates with the scrambled/encoded content and the content player/decoder are authenticated with one another then the content player/decoder can decode/descramble the encoded content (see column 6, lines 15-20).

7. In regards to claim 7, Nardone's design disclosed above describes the tamper resistant decoder (lockable decoding function) that is used in decoding encoded media content received by the I/O devices. Nardone's disclosures meets the limitations set forth under claim 7 that call for having the memory resident program between the operating system and the device driver for the removable media reader because the tamper resistant decoder (memory resident program with lockable decoding function) is activated by the processor (containing the operating system) to control the flow of information between the processor (containing the operating system) and the I/O devices.



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8. In regards to claims 25, Nardone's design disclosed above meets the limitations set forth under claim 25 that call for having the unlocking and enabling of the lockable decoding function being performed by a memory resident program because in Nardone's design the tamper resistant decoder (lockable decoder) is activated by instructions contained within the system processor and tamper resistant decoder.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9, 10, 12, 13, 17, 18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardone in view of Angelo (U.S. Patent No. 6625730). In regards to claims 9, 10, 12, 13, 17, 18, 23 and 24, Nardone's design disclosed above meets all of the aforementioned limitations set forth under claims 6, 11, 16, and 22. However Nardone's design makes no mention of storing the predetermined signature in the BIOS circuitry and also in non-volatile memory of the central processing unit. Angelo teaches in column 8, lines 47-51 that it is common to store the BIOS in non-volatile memory. Nardone further discloses in column 8, lines 38-48 how signatures can be stored in the BIOS for

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the purposes of validating the BIOS. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Angelo's teachings on storing signatures in the BIOS, which can be contained in the non-volatile memory of a processor, into Nardone's design in order to achieve a design that is capable of allowing the predetermined signature to be stored in the BIOS or non-volatile memory in the central processing unit for the purpose of storing the predetermined signature in an area known to be secure.

#### ***Allowable Subject Matter***

11. Claims 4, 5, 8, 14, 15, and 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph McArdle whose telephone number is (703) 305-7515. The examiner can normally be reached on Weekdays from 8:00 am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

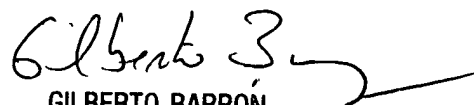
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph McArdle  
Examiner  
Art Unit 2132

jmm



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